

REMARKS

The Office Action dated June 16, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-34 are pending and under consideration, including independent claims 1, 11, 14, 20, 23, and 34. More specifically, Applicants herein amended claims 1, 5, 11, 14, 20, 21, 23, and 34 to more particularly point out and distinctly claim the present invention. It is respectfully submitted that the amendment adds no new subject matter to the present application and serves only to place the present application in better condition for examination. Therefore, entry of the amendment and consideration of the pending claims, as amended, are respectfully requested. It is believed that all grounds for rejection in the Office Action have been addressed and that the present application is currently in condition for allowance in view of the amendment and the following comments. Reconsideration of and allowance of claims 1-34 are respectfully requested.

The Office Action rejected claims 1 through 34 under 35 U.S.C. §102(e) as being anticipated by U. S. Published Patent Application No. 20030054865 to Byers et al. (the "Byers" reference). The Office Action took the position that Byers describes all the recitations of independent claims 1, 11, 14, 20, 23, and 34 and their related dependent claims. Applicants respectfully urge that this rejection is legally and technically improper and should be withdrawn in view of the following explanations.

Independent claim 1, upon which claims 2-10 and 24-26 are dependent, recites a method, including detecting a call establishment request, in response to said detecting, alerting a called terminal, in response to said alerting, setting up a two-way connection between a calling terminal and the called terminal, determining that a two-way voice call between the calling terminal and the called terminal is not allowed, receiving visual messages via the called terminal and/or the calling terminal, and conveying said visual messages to the calling terminal and/or the called terminal, respectively.

Independent claim 11, upon which claims 12-13 and 27 are dependent, recites an apparatus, including a detecting unit configured to detect a call establishment request, an alerting unit configured to alert a called terminal in response to said call establishment request, and a setting up unit configured to set-up, in response to said alerting, a two-way connection between a calling terminal and the called terminal. The apparatus also includes a determining unit configured to determine that a two-way voice call between the calling terminal and the called terminal is not allowed, a receiving unit configured to receive visual messages via the called terminal, and a conveying unit configured to convey said visual messages to the calling terminal.

Independent claim 14, upon which claims 15-19 and 28 are dependent, recites an apparatus being configured to detect a call establishment request, in response to said detection, set up a two-way connection between a calling terminal and a called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, receive visual messages via the called terminal, and convey said visual messages to the calling terminal.

Independent claim 20, upon which claims 21-22 and 29 are dependent, recites a user interface in a called terminal and/or a calling terminal, wherein the user interface is configured to select a desired call mode, in response to said selection, setting up a two-way connection between the calling terminal and the called terminal, and if a two-way voice call between the called terminal and the calling terminal is not allowed, receive and convey visual messages from the calling terminal and/or the called terminal.

Independent claim 23, upon which claims 30 through 33 are dependent, recites a communication system configured to detect a voice call establishment request from a calling terminal to a called terminal, in response to said detecting, alert the called terminal, in response to said alert, set up a two-way connection between the calling terminal and the called terminal, determine that a two-way voice call between the calling terminal and the called terminal is not allowed, and receive visual messages via said called terminal and/or calling terminal and convey said visual messages to the calling terminal and/or the called terminal, respectively.

Independent claim 34 recites a apparatus, including means for detecting a call establishment request, means for alerting a called terminal in response to said call establishment request, means for setting up, in response to said alerting, a two-way connection between a calling terminal and the called terminal, means for determining that a two-way voice call between the calling terminal and the called terminal is not allowed, means for receiving visual messages via the called terminal, and means for conveying said visual messages to the calling terminal.

As will be discussed below, Byers fails to disclose or suggest the elements of any of the presently pending claims.

Byers generally relates to providing a courtesy alerting feature. In Byers, a mobile electronic device, such as a cellular phone, a pager, or a PDA receives a call request. If the user of the mobile electronic device wants to answer the call request but cannot do so immediately, the user activates a courtesy alerting feature using an input device on the mobile device by pressing a key or sequence of keys on the mobile device. A message is sent to the calling party alerting them that the user of the mobile device cannot currently answer the call but is moving to a place where the call request can be taken. Once in a location where the call can be taken, the user presses an answer button on the mobile device and the call is completed.

In view of this and other disclosure in Byers, it can be seen that the reference generally provides to a communication system in which an audio message is played to a calling party to indicate that the called party is currently unavailable but will be taking the call shortly. Specifically, the called party receives an indication of the call and depresses a selected key or button to indicate that a message should be played to the calling party. The called party may further depress a second key or button select a message to be played to the calling party. In Byers, the call is connected but placed on hold until the called party indicates a readiness to take the call. In summary, Byers allows a called party to receive notice of a requested incoming call and to return an audio message to the calling party that the called party is temporarily refusing the call.

In contrast, recited embodiments of the subject application generally enable a called party to receive notice of an incoming audio communication and to respond to this incoming communication with a **visual message back to the calling party**. In embodiments of the subject application, the visual message, such as a text message, may be either directly forwarded to the calling party or translated into an audio message and forwarded to the calling party.

Regarding the exchange of visual messages, the Office Action cited to Byers at paragraphs [0020]-[0021] that describes that user may depress a “courtesy” key to indicate to the caller that communications are not currently available and to play back either **a default or a select message**. Thus, Applicants note that the message received in Byers (*i.e.*, the pressing of the “Courtesy” button) is not the message conveyed to caller. In no way does the Byers disclose or suggest that a visual message is received from the called party and the this message is conveyed to the calling party. The Office Action alleged that the audio message is “silent” because the message is pre-recorded.

In view of the above-described aspects of Byers, Applicants urge that Byers does not teach every limitation of the recited embodiments, and aspects of the subject application may be distinguished from the disclosure of Byers. For example, claim 1 recites that visual messages are conveyed between the called terminal and the calling terminal. In contrast, Byers teaches only the exchange of pre-recorded audio messages between the two terminals. For at least these reasons, Byers fails to teach or suggest all the recitations of independent claim 1, and the rejection of claim 1 is traversed in view of the present remarks. On similar grounds, dependent claims 2 through 10 should likewise

be allowable as depending from allowable claim 1. Reconsideration and allowance thereof is respectfully requested.

Because independent claims 11, 14, 20, 23, and 34 include similar claim features as those recited in independent claim 1, although of different scope, and because the Office Action refers to similar portions of the cited references to reject independent claims 11, 14, 20, 23, and 34, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 11, 14, 20, 23, and 34 and the claims depending therefrom.

As described in greater detail below, Applicants further note that Byers does not teach recitations contained in several dependent claims. Accordingly, even if the claims continue to be rejected in view of Byers, at least claims 4, 10, and 17 should be separately allowable for the reasons provided below. Applicants further note that these arguments are not addressed in the Office Action, which is therefore incomplete. If additional arguments and/or prior art references are needed to reject these and other claims in a new Office Action, that new Action must be non-final.

Applicants urge that Byers does not teach or suggest the recitations of claim 4. Claim 4 includes the limitation that the two-way connection is or comprises a chat connection. As described in the specification of the subject application and as well-known in telecommunications, chatting (also known as text messaging) refers to the sending of short text messages between mobile phones using the Short Message Service (SMS). There is no suggestion in Byers of any non-voice communications, let alone a chat connection. For at least these reasons, Applicants urge that claim 4 should be

allowable since Byers does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Likewise, claim 10 should also be separately allowable. Claim 10 contains the recitation that the converting of visual messages to speech is carried out by a network element. Byers in no way describes or suggests that a network element performs the text-to-speech conversion. Byers discloses, instead, that the corresponding element is present on the called terminal. For at least these reasons, Applicants urge that claim 10 should be separately allowable since Byers does not teach or suggest all of the recited limitations. Reconsideration and allowance thereof is respectfully requested.

Claim 17 contains the recitation that the claimed apparatus includes a mode converter configured to change a call from a voice call to a non-voice call. As described above in the discussion of claim 4 regarding the use of chatting in the subject application, Byers does not teach or suggest the use of text message or other non-voice calls, let alone describe the use of a mode converter as recited in claim 17. The Office Action argues that Byers teaches converting a visual message to a recorded voice message for transmission through a voice call to the calling terminal. Applicants note that this argument ignores the limitation of converting between a voice call and a non-voice call since Byers teaches to communicate only with a voice call. For at least these reasons, Byers does not teach the limitations of claim 17, and this claim should also be separately allowable as well. Reconsideration and allowance of claim 17 is respectfully requested.

Applicants respectfully submit that each of claims 1-34 recites features that are neither disclosed nor suggested in any of the cited references. Accordingly, it is

respectfully requested that each of claims 1-34 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, consisting of a large, stylized 'D' followed by a horizontal line extending to the right.

David D. Nelson
Registration No. 47,818

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

DDN/cqc